



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/097,035	06/12/98	KROM	J 9608042

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IM22/0830

EXAMINER

WILSON, D

ART UNIT	PAPER NUMBER
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1713

DATE MAILED:

08/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Advisory Action

Application No.  
09/097,035

Applicant(s)  
Krom et al.

Examiner  
D.R. Wilson

Group Art Unit  
1713



THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Aug 21, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

- ☒ The proposed amendment(s):
- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
- ☐ they raise the issue of new matter. (See note below).
- ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See attachment.

- ☒ Applicant's response has overcome the following rejection(s):  
See attachment.

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):
- Claims allowed: \_\_\_\_\_
- Claims objected to: \_\_\_\_\_
- Claims rejected: 1-4, 6-10, 13, 14, 21, and 22
- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.
- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Other

D.R. WILSON  
PRIMARY EXAMINER  
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### **ADDITIONAL COMMENTS**

#### **1. Response to Proposed Amendment After Final**

Applicant's proposed amendment filed 8/21/00, after final rejection, has been fully considered with the following results.

a. The proposed amendment will not be entered because it narrows the scope of the claimed subject matter and raises no issues which requires further consideration and/or search. Specifically, (i) the language "consisting essentially of" narrows the scope of the claimed subject matter, and (ii) in thrice amended Claim 2, there is no antecedent basis for "compounds". In regards to (i), applicant's argument that they are merely using traditional language suggested by the Examiner, and that the concept of excluding a "nitrile rubber" has already been considered is incorrect. The Examiner's suggestion was that conventional transitional phrases be used, as opposed to the indefinite phrases used. What has been examined is what has been used, not what might be used. Applicant is also advised that the phrase "consisting essentially of" does not necessarily exclude other components.

b. The proposed amendment if entered would have overcome the new matter objection and corresponding rejection of claims under 35 U.S.C. 112, first paragraph, concerning "conjugated diene units", and in this regard the rejection would have been withdrawn. However, the amendment does not address the issue of there being no basis for the second polymer being a vulcanized polymer, and in this regard the objection and rejection would be maintained. The issue is not as argued by applicant whether or not Claim 22 is enabled for a non-vulcanized second polymer. The issue is enablement for the claims not limited to the second polymer being non-vulcanized.

c. Upon reconsideration the rejection of Claims 21-22 under 35 U.S.C. 112, second paragraph, is withdrawn.

d. The proposed amendment if entered would have overcome the rejection of claims under 35 U.S.C. 112, second paragraph, regarding (i) the language "comprised substantially" in Claim 1, (ii) the language "polymer comprising polybutadiene" of Claims 7 and 9, and (iii) antecedent basis for the language of Claim 10, and in this regard the rejection would have been withdrawn. However, the

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amendment would not have overcome the rejection concerning the indefiniteness of Claim 2, and further would raise a new issue for consideration as noted above.

e. The argument traversing the rejection of Claims 1-4, 6-10, 13-14 and 21-22 under 35 U.S.C. 102(b) as being anticipated by Coran, to the degree that it is based upon the language "consisting essentially of" is not considered because it is not the claimed invention which has been rejected. However, it is to be noted that "consisting essentially of" does not necessarily effectively exclude the necessary nitrile constituent of the Coran polymer, as is argued by applicant. Applicant would need to show that the presence of the nitrile constituent would "--- materially effect the basic and novel characteristic(s) of the claimed invention." (see M.P.E.P. § 2111.03).

The argument that the instant invention uses the amine functionalized polymer as a major component whereas Coran only uses it as a compatibilizer in small amounts is not deemed to be persuasive because the language of the claims do not require any specific amount of the second polymer. It is also well settled that the purpose of including the amine functionalized polymer does not have to be the same as applicants.

*A prima facie* case of obviousness (for a composition) does not require the solution of the same problem or recognition of the same advantages as the applicants invention. *In re Dillon* 16 USPQ2nd 1897 (CAFC, en banc, 1990), which overrules *In re Dillon* 13 USPQ 2nd 1337 and *In re Wright* 6 USPQ 2nd 1959.

In regards to no motivation to modify the reference, the rejection is an anticipatory rejection and is not based upon any modification of the reference.

f. The argument traversing the rejection of Claims 1-4, 6-10, 13-14 and 21-22 under 35 U.S.C. 103(a) as being unpatentable over Berta in view of Stayer, Jr. and Admissions by Applicant, is also not deemed to be persuasive. Applicant argues that there would be no motivation to select as the functionalized polymer to modify in Berta, the hydroxy-terminated polybutadiene, because it is only one of seven alternatives. However, in as much as it is one of the functionalized polymers specifically mentioned one of ordinary skill in the art would clearly envision it as one of the functional polymers to use. It is then also argued that "--- the skilled artisan is faced with considering all possible substituents for each of the seven potential functionalized polymers ---" and that "[t]he resultant number of possibilities is countless".

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This is not deemed to be persuasive because there are only two functional groups reactive with the anhydride groups within the teachings of Berta - amino and hydroxyl groups. Clearly, this does not create a countless number of possibilities as alleged. It is further argued that "--- no motivation exists to link the amine-terminated olefin/alkylene oxide copolymer with the polybutadiene as a teaching on amine functionality." This is not deemed to be persuasive because (i) Berta teaches that the functionalized polymers react with the anhydride groups of the grafted polymers (col. 5, lines 25), and (2) the only functional groups taught are hydroxyl and amine, the amine being taught both in the amine-terminated polyalkylene glycols and olefin/alkylene oxide copolymers. Applicant does not rebut the stated motivation that

"--- it would have been obvious to one of ordinary skill in the art to use an amine-terminated polybutadiene with the expectation of achieving a polypropylene grafted with polybutadiene which is equivalent for the intended purpose to that prepared from the hydroxy terminated polybutadiene."

The argument that the functionalized polymer is only 2 to 8 parts per hundred of the thermoplastic olefin, or that it is only a minor constituent, is not deemed to be persuasive because applicants claims read on such compositions. The instant claims do not require that the functionalized polymer be a major constituent.

The argument that Berta's comparative experiments somehow show that the functionalized polymers do not react with the grafted polymers is interesting but not convincing. That the oxidized polyethylene wax may also react with the grafted copolymer, or that the wax is a critical component, does not prove that the functionalized polymers do not react with the grafted polymers. The argument that it is known in the art that reaction only occurs at the interface of incompatible polymers is also not deemed to be persuasive. Even if they only react at the interface, they still react. Further, it would be expected that once they react at the interface, the resultant graft polymers become compatibilizing agents for further reaction.

## 2. Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D.R. Wilson whose telephone number is (703) 308-2398. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, may be reached at (703) 308-2450.

The fax phone number is (703) 305-5408 or 5433. The after final fax number is (703) 305-3599.